

REMARKS

This is a full and timely response to the non-final Official Action mailed **September 18, 2008** (the “Office Action” or “Action”). Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

Claim Status:

By the foregoing amendment, the specification and various claims have been amended. Further, original claims 1 and 3 have been cancelled without prejudice or disclaimer. Thus, claims 2, and 4-45 are currently pending for further action.

Objection to Drawings:

In the recent Office Action, the drawings were objected to under 37 C.F.R. 1.83(a) for failing to show every feature of the invention specified in the claims. Specifically, the Office Action included the below statements indicating that deficiencies exist. Arguments in connection with these alleged deficiencies are addressed with the respective statements.

1. The Office Action states that “the network server and Internet server storing said database (Claims 10, 11, 38, and 39) . . . must be shown or the feature(s) canceled from the claim(s).” Fig. 2 has been amended to include a network server (108) and internet server (109). Support for the amendment to Fig. 2 can be found in Applicant’s originally filed specification at, for example, paragraph [0022]. No new matter has been added.
2. The Office Action also states that “the step/means for requiring authentication to access said database (Claims 12 and 40) must be shown or the feature(s) canceled from the

claim(s).” Fig. 5 has been amended to include a step for authentication of server access (step 407). Support for the amendment to Fig. 5 can be found in Applicant’s originally filed specification at, for example, paragraph [0043]. No new matter has been added.

3. The Office Action also states that “the step of modifying printing device settings and the additional step of configuring said printing device (Claims 1 & 2) must be shown or the feature(s) canceled from the claim(s).” This objection is moot due to the cancelation of claim 1 in the present paper. Therefore, no amendments to the drawings have been made in connection with claim 1 and 2.

4. The Office Action also states that “the step of obtaining configuration settings (claim 44) and the additional step of obtaining configuration settings (claim 45) must be shown or the feature(s) canceled from the claim(s).” This objection has been overcome through an amendment to claim 45 as discussed below. Therefore, no amendments to the drawings have been made in connection with claim 44.

No new matter has been added. Following the above remarks, all the Drawings and associated claims are believed to be in compliance with 37 C.F.R. 1.83(a) and notice to that effect is respectfully requested.

Objection to the Claims:

In the outstanding Office Action, the Examiner objected to various claims because of one or more informalities. These issues have been corrected by the present amendment. No

new matter has been added. Therefore, following entry of this amendment, the objection to the claims should be reconsidered and withdrawn.

35 U.S.C. § 112, second paragraph:

In the recent Office Action, claims 5-11, 19, 20, 22 and 23 were rejected under 35 U.S.C. § 112, second paragraph. These claims have been carefully reviewed in light of the Examiner's comments.

While Applicant does not necessarily agree that any of these claims were indefinite as filed, the indicated claims have been amended herein to address the issues raised by the Examiner under 35 U.S.C. § 112, second paragraph. The rejection of claims 5-11, 19, 20, 22, and 23 are addressed as follows.

Claim 2: The Office Action states that “[i]t is unclear if the claimed method is modifying printing device settings and configuring the printing device setting again later.” This rejection is now moot due to the cancellation of claim 1 in the present paper.

Claims 19, and 21-23: The Office Action states that “[i]t is extremely confusing as to whether this database is a physical unit of said printing device. If so, how can a physical unit be stored in a memory of a physical printer? Or is the database simply a set of data?” (Action, p. 5). In response, one of ordinary skill in the art would understand a database to be a comprehensive collection of related data organized for convenient access, generally in a computer. In support of this, the specification clearly states that “[t]he database may be stored in printing device memory, on a network server, or on a remote web or Internet server.” (Applicant’s specification, para. [0022]). Further, the specification clearly states that

“predefined configuration settings, along with [,for example,] identifier and location information may be stored in table or list form in a database that is stored on or accessible to [,for example,] the printing device,” and that “[t]he database, as previously mentioned, may be stored in printing device memory, on a network server, or on a remote web or Internet server.” (Applicant’s specification, paras. [0024] and [0025]). Therefore, Applicant’s specification clearly states that the database may be data stored on memory contained in devices such as a printer, a network server, or on a remote web or internet server.

Claims 22 and 23 have been amended to clarify that the database may be stored on a network server and a web server or Internet server communicatively connected to the printing device. Support for the amendment to claims 22 and 23 can be found in Applicant’s originally filed specification at, for example, paragraphs [0030] and [0042], and Fig. 2.

Claim 26: The Office Action states that there is insufficient antecedent basis for the limitations of “said data packet,” and “said identification information.” Claim 26 has been amended to depend from claim 25. Support for the amendment to claim 26 can be found in Applicant’s originally filed specification at, for example, paragraphs [0039] and [0041]. Following this amendment, claim 26 has sufficient antecedent basis, and notice to that effect is respectfully requested.

Claim 32: The Office Action states that there is insufficient antecedent basis for the limitation of “said printing device function.” Claim 32 has been amended to recite that the configuration of the printing device occurs automatically. Support for the amendment to claim 32 can be found in Applicant’s originally filed specification at, for example, paragraphs

[0023] and [0041]. Following this amendment, claim 32 has sufficient antecedent basis, and notice to that effect is respectfully requested.

Claim 45: The Office Action states that due to the recitation of “obtaining configuration settings” in both claims 44 and 45, “[i]t is unclear if said instruction causes said printing device to obtain the settings twice based in the same identifier.” (Action, p. 5).

Consequently, claim 45 has been amended to recite that the instructions further cause the printing device to identify a location of a client device submitting said print job based on said identifier, wherein the step of obtaining configuration settings associated with said identifier comprises obtaining configuration settings associated with said location. Support for the amendment to claim 26 can be found in Applicant’s originally filed specification at, for example, paragraphs [0039] and [0041]. Following this amendment, claim 45 has sufficient antecedent basis, and notice to that effect is respectfully requested.

Claims 16 and 17: The Office Action states that because claim 16 recites “determining a group to which said printing device belongs based on said identifier,” that it is unclear how a group to which a printing device belongs is determined based on paragraph [0039] of Applicant’s specification. (Action p. 6). Consequently, claim 16 has been amended to recite” determining a group to which said client belongs based on said identifier.” Support for the amendment to claim 16 can be found in Applicant’s originally filed specification at, for example, paragraph [0039]. Following this amendment, claims 16 and 17 are sufficiently definite, and notice to that effect is respectfully requested.

Claim 20: The Office Action states that, because claim 16 recites “a database associating identifiers with printing device locations and printing device locations with printing device configuration settings,” it is unclear how the identifiers are associated with printing device locations based on paragraph [0039] of Applicant’s specification. (Action pp. 6-7).

Consequently, claim 20 has been amended to recite” a database associating identifiers with source locations and source locations with printing device configuration settings.” Support for the amendment to claim 20 can be found in Applicant’s originally filed specification at, for example, paragraph [0039]. Following this amendment, claim 20 is sufficiently definite, and notice to that effect is respectfully requested.

Claims 42 and 43: The Office Action states, in analogy to claims 16 and 17, that because claim 42 recites “means for determining a group to which said printing device belongs based on said identifier,” that it is unclear how a group to which a printing device belongs is determined based on paragraph [0039] of Applicant’s specification. (Action p. 6).

Consequently, claim 42 has been amended to recite” means for determining a group to which said client belongs based on said identifier.” Support for the amendment to claim 42 can be found in Applicant’s originally filed specification at, for example, paragraph [0039].

Following this amendment, claims 42 and 43 are sufficiently definite, and notice to that effect is respectfully requested.

Following the above amendments, all the remaining claims are believed to be in compliance with 35 U.S.C. § 112 and notice to that effect is respectfully requested.

Prior Art:Rejections under 35 U.S.C. §102(e):

In the recent Office Action, claims 1-7, 9, 12, 15, 18, 19, 21, 24, 28-35, 37, 40, 41, and 44 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Application Publication No. 20040212834 to Edwards (hereinafter “Edwards”). For at least the following reasons, this rejection should be reconsidered and withdrawn.

Claim 2:

Claim 2 recites:

A method of configuring a printing device comprising:
 scanning data packets of an incoming print job for an identifier
 identifying a client submitting said print job;
 *querying a database to determine the physical location of said client
based on said identifier;*
 querying said database to obtain settings for said printing device
 associated with said physical location; and
 *configuring said printing device according to said settings associated
with said physical location.*

(Emphasis added).

Support for the amendment to claim 2 can be found in Applicant’s originally filed specification at, for example, paragraphs [0021], [0024], [0025], [0038], and [0039], and claim 3.

In contrast, Edwards does not teach or suggest a method of configuring a printing device comprising querying a database to determine the physical location of a client based on an identifier, and configuring the printing device according to settings associated with the location. The Office Action states, with regard to claim 3, that “the location of media selection parameters in the mapping module associated with *the IP address* must be determined in order to retrieve the parameter from the data.” (Action, p. 8) (emphasis added).

However, an IP address is not a physical location. Edwards states that “[i]n an embodiment of the invention, the multi-media printer 130 may be able to determine the media selection parameters based on the network identity included in the print job. The identity network may be an *IP address*” (Edwards, para. [0040]) (emphasis added). In other words, Edwards simply teaches determine media selection parameters based on an IP address.

In contrast, as recited in claim 2, a printing device may be configured according to settings associated with a physical location. Edwards does not teach a printing device may be configured according to settings associated with a *physical location*. This subject matter is entirely outside the teachings of Edwards.

“A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131. Therefore, for at least the reasons explained here, the rejection based on Edwards of claim 2 and its dependent claims should be reconsidered and withdrawn.

Claim 18:

Claim 18 recites:

A printing device comprising:
an input for receiving a print job; and
a print engine configured to produce a hardcopy from said print job;
wherein said printing device extracts an identifier from said print job
and adjusts printing device configuration settings based on said identifier,
*wherein said printing device configuration settings comprise any of
a resolution setting, addition of a feature to be printed with said print job
and combinations thereof, and combinations thereof.*
(Emphasis added).

Support for the amendment to claim 18 can be found in Applicant's originally filed specification at, for example, paragraph [0005].

In contrast, Edwards does not teach or suggest a printing device as claimed in which configuration settings are adjusted based on a client identifier, where the setting adjusted is either a resolution setting, an addition of a feature to be printed with the print job or a combination thereof.

Specifically, Edwards teaches that “. . . the multi-media printer 130 may be able to determine the *media selection parameters* based on the network identity included in the print job.” (Edwards, para. [0040]). Thus, the only parameters that Edwards suggests as “media selection parameters” to consists of media type and media size. (See Edwards, para. [0045]). Again, Edwards does not teach or suggest a printing device as claimed in which configuration settings are adjusted based on a client identifier, where the setting adjusted is either a resolution setting, an addition of a feature to be printed with the print job or a combination thereof.

“A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131. Therefore, for at least the reasons explained here, the rejection based on Edwards of claim 18 and its dependent claims should be reconsidered and withdrawn.

Claim 29:

Claim 29 recites:

A system for configuring a printing device, said system comprising:
means for extracting an identifier from an incoming print job
identifying a client submitting said print job; and
means for dynamically modifying printing device settings based on
said identifier,
***wherein said printing device settings comprise settings associated
with parameters selected from the group consisting of resolution, amount of
ink used, amount of toner used, addition of letterhead, addition of a logo,
addition of a signature, and combinations thereof.***

(Emphasis added).

Support for the amendment to claim 29 can be found in Applicant's originally filed specification at, for example, paragraph [0005].

As similarly argued above with regard to the patentability of claim 18, Edwards does not teach or suggest a system for configuring a printing device wherein printing device settings comprise settings associated with parameters selected from the group consisting of resolution, amount of ink used, amount of toner used, addition of letterhead, addition of a logo, addition of a signature, and combinations thereof.

Edwards does not disclose that such parameters may include resolution, amount of ink used, amount of toner used, addition of letterhead, addition of a logo, addition of a signature, and combinations thereof. Therefore, Edwards does not teach or suggest modifying settings associated with parameters selected from the group consisting of resolution, amount of ink used, amount of toner used, addition of letterhead, addition of a logo, addition of a signature, and combinations thereof.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed.

Cir. 1987). See M.P.E.P. § 2131. Therefore, for at least the reasons explained here, the rejection based on Edwards of claim 29 and its dependent claims should be reconsidered and withdrawn.

Claim 44:

Claim 44 recites:

A computer readable medium having computer executable instructions thereon which, when executed, cause a printing device to:
scan a print job for an identifier;
obtain configuration settings associated with said identifier; and
configure said printing device according to said configuration settings,
wherein said configuration settings comprise settings associated with parameters selected from the group consisting of resolution, amount of ink used, amount of toner used, addition of letterhead, addition of a logo, addition of a signature, and combinations thereof.

(Emphasis added).

Support for the amendment to claim 44 can be found in Applicant's originally filed specification at, for example, paragraph [0005].

As similarly argued above with regard to the patentability of claims 18 and 29, Edwards does not teach or suggest a computer readable medium having computer executable instructions thereon wherein configuration settings comprise settings associated with parameters selected from the group consisting of resolution, amount of ink used, amount of toner used, addition of letterhead, addition of a logo, addition of a signature, and combinations thereof.

Edwards does not disclose that such parameters may include resolution, amount of ink used, amount of toner used, addition of letterhead, addition of a logo, addition of a signature, and combinations thereof. Therefore, Edwards does not teach or suggest modifying settings associated with parameters selected from the group consisting of resolution, amount of ink

used, amount of toner used, addition of letterhead, addition of a logo, addition of a signature, and combinations thereof.

“A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131. Therefore, for at least the reasons explained here, the rejection based on Edwards of claim 44 and its dependent claims should be reconsidered and withdrawn.

Rejections under 35 U.S.C. §103(a):

In the recent Office Action, claims 8, 13, 16, and 17 were rejected under 35 U.S.C. § 103(a) over Edwards in view of U.S. Patent No. 6,665,715 to Houri (hereinafter “Houri”). The rejection of claims 8, 13, 16, and 17 should be reconsidered and withdrawn for at least the same reasons given above in favor of the patentability of independent claim 1.

In the recent Office Action, claims 10 and 11 were rejected under 35 U.S.C. § 103(a) over Edwards in view of U.S. Patent Application Publication No. 2004/0098471 to Shima (hereinafter “Shima”). The rejection of claims 10 and 11 should be reconsidered and withdrawn for at least the same reasons given above in favor of the patentability of independent claim 1.

In the recent Office Action, claim 14 was rejected under 35 U.S.C. § 103(a) over Edwards in view of Houri and in further view of U.S. Patent Application Publication No. 2003/0135597 to Masuda (hereinafter “Masuda”). The rejection of claim 14 should be

reconsidered and withdrawn for at least the same reasons given above in favor of the patentability of independent claim 1.

In the recent Office Action, claims 20, 25, and 26 were rejected under 35 U.S.C. § 103(a) over Edwards in view of Hourì. The rejection of claims 20, 25, and 26 should be reconsidered and withdrawn for at least the same reasons given above in favor of the patentability of independent claim 18.

In the recent Office Action, claims 22 and 23 were rejected under 35 U.S.C. § 103(a) over Edwards in view of Shima. The rejection of claims 22 and 23 should be reconsidered and withdrawn for at least the same reasons given above in favor of the patentability of independent claim 18.

In the recent Office Action, claim 27 was rejected under 35 U.S.C. § 103(a) over Edwards in view of U.S. Patent Application Publication No. 2001/0025307 to Venkatraman et al. (hereinafter “Venkatraman”). The rejection of claim 27 should be reconsidered and withdrawn for at least the same reasons given above in favor of the patentability of independent claim 18.

In the recent Office Action, claims 36, 42, and 43 were rejected under 35 U.S.C. § 103(a) over Edwards in view of Hourì. The rejection of claims 36, 42, and 43 should be reconsidered and withdrawn for at least the same reasons given above in favor of the patentability of independent claim 29.

In the recent Office Action, claims 38 and 39 were rejected under 35 U.S.C. § 103(a) over Edwards in view of Shima. The rejection of claims 38 and 39 should be reconsidered and withdrawn for at least the same reasons given above in favor of the patentability of independent claim 29.

In the recent Office Action, claim 45 was rejected under 35 U.S.C. § 103(a) over Edwards in view of Hourii. The rejection of claim 45 should be reconsidered and withdrawn for at least the same reasons given above in favor of the patentability of independent claim 44.

Conclusion:

In view of the foregoing arguments, all claims are believed to be in condition for allowance over the prior art of record. Therefore, this response is believed to be a complete response to the Office Action. However, Applicant reserves the right to set forth further arguments in future papers supporting the patentability of any of the claims, including the separate patentability of the dependent claims not explicitly addressed herein. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed.

The absence of a reply to a specific rejection, issue or comment in the Office Action does not signify agreement with or concession of that rejection, issue or comment. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicants

expressly do not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

If the Examiner has any comments or suggestions which could place this application in better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

DATE: December 18, 2008

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